

Doc Code: AP PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) Y0999-411	
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents P O Box 1450 Alexandria VA 22313-1450" [37 CFR 1 8(a)]</p> <p>on _____</p> <p>Signature _____</p> <p>Typed or printed name _____</p>		Application Number 09/437,352	Filed 11/9/99
		First Named Inventor Kanevsky et al.	
		Art Unit 2132	Examiner Karibz Zand
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request</p> <p>This request is being filed with a notice of appeal</p> <p>The review is requested for the reason(s) stated on the attached sheet(s)</p> <p>Note: No more than five (5) pages may be provided</p>			
<p>I am the</p> <p><input type="checkbox"/> applicant/inventor</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed (Form PTO/SB/86)</p> <p><input checked="" type="checkbox"/> attorney or agent of record Registration number <u>36,597</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1 34 Registration number if acting under 37 CFR 1 34 _____</p>		 <p>Signature</p> <p><u>Kevin M. Mason</u></p> <p>Typed or printed name</p> <p>(203) 255-6560</p> <p>Telephone number</p> <p><u>November 3, 2006</u></p> <p>Date</p>	
<p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of _____ forms are submitted.</p>			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P O Box 1450, Alexandria, VA 22313-1450

If you need assistance in completing the form call 1-800-PTO-9199 and select option 2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

5 **Patent Application**

Applicant(s): Kanevsky et al.

Docket No.: YO999-411

Serial No.: 09/437,352

10 Filing Date: November 9, 1999

Group: 2132

Examiner: Kambiz Zand

15 Title: Methods and Apparatus for Verifying the Identity of a User Requesting
Access Using Location Information

20 MEMORANDUM IN SUPPORT OF
PRE-APPEAL BRIEF REQUEST FOR REVIEW

25 Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

30 Sir:

The present invention and prior art have been summarized in Applicants' prior responses.

35 STATEMENT OF GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1 through 58 are presently pending in the above-identified patent application. In the present Office Action, the Examiner indicated that the claims are rejected as indicated in the prior final Office Action dated December 6, 2004. In the cited Office Action, claims 1-11, 13, 15-21, 24, 26-32, 35, 37-39, 40-47, 49, and 50-57 were 40 rejected under 35 U.S.C. §103(a) as being unpatentable over Li et al. (United States Patent Number 6,219,793 B1), and further in view of MacDoran et al. (United States

Patent Number 5,757,916), and claims 12, 14, 22, 23, 25, 33, 34, 36, 48, and 58 were rejected under 35 U.S.C. §103(a) as being unpatentable over Li et al. in view of MacDoran et al., and further in view of “Wireless Enhanced 9-1-1 Service – Making it a Reality,” Bell Labs Technical Journal (Autumn 1996) by Meyer et al. (hereinafter Meyer et al.).

5

Argument

Independent Claims 1, 16, 27, 38, 39, 42, 45, 49, 52 and 55

Independent claims 1, 16, 27, 38, 39, 42, 45, 49, 52, and 55 are rejected
10 under 35 U.S.C. §103(a) as being unpatentable over Li et al., and further in view of MacDoran. In the prior final Office Action dated December 6, 2004, the Examiner asserts that Li teaches a challenge-response to authenticate a wireless communication, but acknowledges that Li does not disclose a “challenge response method that uses the location.” The Examiner asserts, however, that MacDoran discloses a “method of
15 providing the location of the client .. and granting access to the user if the location is within a predetermined threshold.”

In the present Office Action, the Examiner asserts that the limitation added in the Voluntary Amendment dated May 23, 2006, has already been considered by the Board of Patent Appeal and Interference (see, page 2, paragraph 1, where the board
20 considered a “portable device” of a user). The Examiner further asserts that, therefore, the added limitation has already been considered by the BPAI and, based on such consideration, a decision has been rendered.

Applicants note that the text cited from the Board decision by the Examiner recites that

25

30

the claimed invention relates to a global positioning system (GPS) –based access control method and apparatus in which access to a device or a secure facility is limited by verifying an authorized user’s location. More particularly, the GPS-based access controls system confirms that a user requesting access is actually physically present at the location of the device or secure location. The user’s location is obtained by use of an individual GPS system carried by each user on a portable device, such as a pocket token, computer-readable card, cellular telephone, or watch. If the location of a person making an access control request does

not match the coordinates of the GPS device worn by an authorized user,

the person requesting access is unauthorized

(Page 1, last paragraph, to page 2, first paragraph, of the Decision on Appeal.)

Clearly, in the text cited by the Examiner, the board is summarizing basic
5 principles of the present invention. The board, however, sustains or overturns the rejections made by the Examiner based on the limitations of the *claims*. Since the limitation added in the Voluntary Amendment was not included in the claim set submitted in the Appeal Brief, the added limitation was not considered by the board in deciding the patentability of the cited patent. Thus, contrary to the Examiner's assertion,
10 the added limitation was *not* considered by the BPAI and the decision rendered was *not* based on such consideration.

In addition, Applicants note that none of the cited references disclose or suggest identifying a location of an authorized person associated with a response, wherein the location is identified by *utilizing a portable device assigned to a user*.

15 Applicants note that MacDoran is directed to a method and apparatus for authenticating the identity of a remote user *entity* where the identity of such user entity is authenticated by use of information specific to geodetic location of the user *entity* (see, Abstract). MacDoran compares the *expected location of an electronic device* with the *current location of the device* and will not allow access if the locations do not match.

20 The present invention, alternatively, is directed to authenticating a user by confirming the location of the user utilizing, for example, a GPS device carried by the user. Thus, MacDoran would require a *single GPS device located at a client machine* and the present invention would require, for example, a *separate GPS device for each user* of the client machine.

25 Applicants also note that MacDoran defines "entity" as an electronic device and specifically states that this definition "*does not extend to individual users* that operate an entity, because the invention does *not* have the ability to authenticate an individual person." (Col. 6, lines 59-65; emphasis added.) Thus, MacDoran actually teaches away from the present invention by teaching that the invention cannot be used to
30 authenticate an individual person.

In any case, MacDoran et al. clearly do not disclose or suggest wherein the location is identified by utilizing a portable device *assigned to a user*. Please note that dictionary.com defines “assign” as “to transfer (property, rights, or interests) from one to another.” Thus, a person of ordinary skill in the art would recognize that the assignment of a portable device to a user infers more than a transient use of the device.

Thus, Li et al. and MacDoran et al., alone or in combination, do not disclose or suggest wherein said location is identified by utilizing a portable device assigned to said user, as required by independent claims 1, 16, 27, 38, 39, 42, 45, 49, 52, and 55.

10 Additional Cited References

Meyer et al. was also cited by the Examiner for its disclosure of asking the cell phone user “Do you have any more details on your location?” (Meyer: page 189, right column, lines 1-2.) Applicants note that Meyer is directed to enhanced 9-1-1 service for wireless networks. Meyer does not disclose or suggest the identification of a user as described in the limitations of the independent claims. Furthermore, Meyer et al do not disclose or suggest wherein the location is identified by utilizing a portable device assigned to a user.

Thus, Li et al., MacDoran et al., and Meyer et al., alone or in combination, do not disclose or suggest wherein said location is identified by utilizing a portable device assigned to said user, as required by independent claims 1, 16, 27, 38, 39, 42, 45, 49, 52, and 55.

Dependent Claims 2-15, 17-26, 28-37, 40, 41, 43, 44, 46-48, 50, 51, 53, 54 and 56-58

Dependent claims 2-11, 13, 15, 17-21, 24, 26, 28-32, 35, 37, 40, 41, 43, 44, 46, 47, and 50, 51, 53, 54, and 56-57 were rejected under 35 U.S.C. §103(a) as being unpatentable over Li et al., and further in view of MacDoran et al. and dependent claims 12, 14, 22, 23, 25, 33, 34, 36, 48, and 58 were rejected under 35 U.S.C. §103(a) as being unpatentable over Li et al. in view of MacDoran et al., and further in view of Meyer et al.

Claims 2-15, 17-26, 28-37, 40-41, 43-44, 46-48, 50-51, 53-54, and 56-58 are dependent on claims 1, 16, 27, 39, 42, 45, 49, 52, and 55, respectively, and are

therefore patentably distinguished over Li et al., MacDoran et al., and Meyer et al. (alone or in any combination) because of their dependency from independent claims 1, 16, 27, 39, 42, 45, 49, 52, and 55 for the reasons set forth above, as well as other elements these claims add in combination to their base claim.

5 All of the pending claims, i.e., claims 1-58, are in condition for allowance and such favorable action is earnestly solicited.

If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Examiner is invited to contact the undersigned at the telephone number indicated below.

10 The Examiner's attention to this matter is greatly appreciated.

Respectfully submitted,



Kevin M. Mason
Attorney for Applicants
Reg. No. 36,597
Ryan, Mason & Lewis, LLP
1300 Post Road, Suite 205
Fairfield, CT 06824
(203) 255-6560

Date: November 3, 2006

15

20